

REMARKS

(1) Double Patenting Rejection

The present application is a continuation of U.S. Patent Application Serial No. 09/323,202 filed on June 1, 1999, now issued to United States Patent No. 6,243,677.

In the Office Action mailed August 16, 2001 in connection with the present continuation application, claims 1, 2, 4 and 19-44 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-29 of U.S. Patent No. 6,243,677.

The present continuation application was filed with the original claims 1-18 of the parent case. By Preliminary Amendment filed contemporaneously with the present application, claims 3 and 5-18 were cancelled, and claims 1 and 2 were amended. In addition new claims 19 to 44 were added.

Claims 1, 2, 4 and 19 to 23 currently pending in this continuation correspond generally to claims 1, 2, 4 and 19 to 23 which were cancelled in the parent case in reply to the second Office Action (made final) mailed on August 16, 2000 in order to put the case in condition for allowance.

In view of the issuance of U.S. Patent No. 6,243,677, the double patenting rejection of at least claims 1, 2, 4 and 19-23 now raised is surprising. The double patenting rejection is based on the assertion that the claims of the present

application are not patentably distinct from the claims of the parent. But the rejection of these claims when the claims of U.S. Patent No. 6,243,677 were allowed indicates that the claims presently pending in this case were patentably distinct.

The present continuation would not have been filed but for the rejection in the parent case of the remainder of the claims. The Office Action now indicates that the remaining claims, enumerated above, are not patentably distinct from the previously allowed claims. Yet, the applicants respectfully submit that the claims must have been patentably distinct for the parent to issue.

The current double patenting rejection therefore seems inconsistent with the previous allowance. The applicant therefore respectfully requests further clarification from the Examiner as to the basis of the rejection under 35 U.S.C., the case law, 37 C.F.R. or the MPEP.

In the meantime, (a) at least in the context of the continued claims 1, 2, 4 and 19 - 23, the applicant submits that a sufficient basis in law to support a double patenting rejection given the issue of U.S. Patent No. 6,243,677 has not yet been established; and (b) the applicant reserves its right to file a terminal disclaimer should the need for such a disclaimer be established.

(2) **Summary of Prosecution to Date**

As previously stated, the present application is a continuation of U.S. Patent Application Serial No. 09/323,202 filed on June 1, 1999, now issued to United States

Patent No. 6,243,677. As such, the prosecution of the parent case is particularly relevant to that of the present case in light of claim rejections set out in the Office Action mailed August 16, 2001. What follows is a brief summary of the prosecution of the parent and continuation cases to date.

(a) **The Parent Case**

The parent case was originally filed with claims 1 to 18. In the first Office Action mailed on January 7, 2000, relating to the parent case, the Examiner cited U.S. Patent No. 2,270,275 to Suciu and U.S. Patent No. 4,871,069 to Guimont as anticipatory references. More specifically, claims 1, 2, 4 and 5 were rejected under 35 U.S.C. 102(b) as being anticipated by Suciu and claims 1-5 were rejected under 35 U.S.C. 102(b) as being anticipated by Guimont.

In response to the first Office Action, the applicant submitted arguments to traverse the anticipatory rejections, amended claims 1 and 5, and added new claims 19 to 41.

In the second (final) Office Action mailed on August 16, 2000, claims 1 and 19-24 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,334,601 to Davis and claims 1 and 19-23 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,941,603 to Creamer et al.

Claim 26 was rejected under 35 U.S.C. 103(a) as being unpatentable over Davis. Claims 2, 4, 28 and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Creamer et al. or Davis in view of Lin.

In addition, claims 24 to 27 were rejected under 35 U.S.C. 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims not specifically mentioned were rejected since they depended from claims rejected under 35 U.S.C. 112, second paragraph.

In response to the second (final) Office Action, the applicant cancelled claims 1, 2, 4, 19-24, 26, 28 and 29, with traverse, to continue prosecution of those claims in this continuation application. Claims 25 and 27 were amended so as to be in condition for allowance.

(b) The Present Continuation Case

The present continuation application was filed with the original claims 1-18 of the parent case. By Preliminary Amendment filed contemporaneously with the present application, claims 3 and 5-18 were cancelled, claims 1 and 2 were amended and new claims 19 to 44 were added with claims 19 to 23 of this continuation corresponding to the cancelled claims 19-23 of the parent case. In addition, the applicant submitted arguments traversing the rejections based on Davis and Creamer et al.

By an Office Action dated August 16, 2001, claims 1, 2, 4, 19-25, 28, 29, 34-37 were rejected. More specifically, claims 1, 2, 23, 24, 28, 34, 35 and 36 were rejected under 35 U.S.C. 102(a) as being clearly anticipated by U.S. Patent No. 5,865,314 of Jacober. As in the previous Office Action of August 16, 2000 relating to the parent case, the Office Action cited U.S. Patent No. 4,334,601 of Davis as an anticipatory reference under 35 U.S.C. 102(b) in respect of claims 1, 19-23, 28 and 29. In like fashion, claims 1, 19-25, 28 and 29 were again rejected as being anticipated by Creamer et al. In addition, claims 2, 4 and 34-37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of U.S. Patent No. 5,472,279 of Lin.

(3) **Claim Rejection - 35 U.S.C. 102 – Anticipation - Law**

Anticipation can only be established by a single prior art reference: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); *Structural Rubber Products Co., v. Park Rubber Co.*, 749 F.2d 7070; 223 U.S.P.Q. 1264 (C.A.F.C. 1984). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The test for anticipation requires that all of the claimed elements must be found in exactly the same situation and united in the same way to perform the same function in a single unit of the prior art. *Studiengesellschaft Kohle, m.b.H. v. Dart Industries, Inc.*, 762 F.2d 724, 726, 220 U.S.P.Q. 841 at 842 (C.A.F.C. 1984). Anticipation cannot be predicated on

teachings in a reference that are vague or based on conjecture. *Datascope Corp. v. SMEC Inc.*, 594 F. Supp. 1036; 224 U.S.P.Q. 694, 698 (D.N.J. 1984).

(4) **Claim Objections under 35 U.S.C. 103(a) – Obviousness - Law**

(a) **Basic Requirements of a *Prima Facie* Case of Obviousness**

Section 2142 of the Manual of Patent Examining Procedure (MPEP) states:

“ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F. 2d 488, 20 USPQ2d 1438 (Fed. Cir 1991).”

...

(b) **Must Have Teaching, Suggestion, or Incentive**

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention *absent some teaching, suggestion or incentive* supporting the combination *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F. 2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir.).

Cited in *In re Geiger*, 815 F.2d at 688, 2 USPQ 2d at 1268 (Fed. Cir. 1987) (Emphasis added).

Obviousness cannot be established by combining references without also providing evidence of the motivating force that would impel one skilled in

the art to do what the patent applicant has done (See *Ex Parte Levensgood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993)).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed toward obvious subject matter, either the references must expressly or impliedly, suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex Parte Clapp*, 227 USPQ972, 973 (Bd. Pat. App. & Inter. 1985) (Emphasis added).

...

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex Parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986)."

(c) Mere Possibility of Combination is Not Sufficient

Section 2143.01 of the Manual of Patent Examining Procedure (MPEP) states:

"FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)."

...

(d) Destruction of Function

"If proposed modifications would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

(5) **Applicant's Arguments & Amendments to the Claims**

(a) **Amendments to the Claims**

In the present response to Office Action, claims 1 and 28 have been amended. Claim 1 has been amended to further define features of the first and second insulated wall structures and the arrangement of first and second insulated chambers. Claim 28 has been re-written in independent form and further recites that the first container portion is securable in the collapsed position.

(b) **Arguments concerning rejections based on 35 U.S.C. 102 - Anticipation**

Re: Davis

Claim 1 was rejected as anticipated by Davis. To anticipate claim 1 the law requires that Davis have all of the features of the claim, in exactly the same situation and united in the same way to perform the same function.

Contrary to the rejection,

- (1) Davis does not disclose first and second *collapsible* insulated container portions. More specifically, Davis does not teach the collapsible feature of the claimed insulated container portions.

- (2) Davis does not show first and second collapsible *insulated* container portions. More particularly, Davis does not teach the insulated feature of the claimed first and second collapsible container portions.
- (3) Davis does not teach or describe *insulated* sidewall panels of the first and second insulated wall structures as recited in claim 1.

The applicant submits that any one of these differences is sufficient to overcome the rejection in respect of claim 1 under 35 U.S.C. 102 according to *Dart Industries* and *Datascope, supra*.

The applicant respectfully traverses this rejection and requests that the rejection of claim 1 under 35 U.S.C. 102 on the basis of Davis be withdrawn for the following reasons:

(i) Davis describes a utility bag having an extensible end compartment A, a main, thermally insulated, central compartment B and a second end compartment C (column 2, lines 46-48). End compartments A and C are both said to be collapsible compartments. However, Davis is silent as to whether central compartment B is collapsible. Davis neither discloses, describes nor suggests that central compartment B is collapsible. Furthermore, the applicant notes that there is nothing in the description of Davis that is inconsistent with central compartment B being non-collapsible. There is no mention in Davis that central compartment B is collapsible.

(ii) The Office Action of August 16, 2001, states: "...to the degree that Davis does not disclose the central compartment B as being made from a rigid material, the

central compartment B is capable of being collapsed as claimed.” The applicant respectfully submits that no basis has been provided for such an assertion. Moreover, this statement is contrary to the test for anticipation, which requires that all of the claimed elements must be found in exactly the same situation, and united in the same way to perform the same function in a single unit of the prior art. *Studiengesellschaft Kohle*, supra. Under U.S. Patent Practice, the Patent Office bears the positive onus of showing each and every feature in the cited reference. Where a feature is neither shown nor described in a cited reference, its existence cannot be inferred merely by reason that the reference does not positively exclude the feature. The onus of showing each and every feature in the cited reference cannot be properly discharged by an inference of this kind. There is clearly no basis in law to support such an approach under 35 U.S.C. 102.

(iii) The applicant respectfully submits that Davis does not disclose the collapsible feature of the insulated container portion of claim 1, and respectfully requests under MPEP 707.07(f), that the Examiner identify a collapsible feature of central compartment B in Davis; or (b) provide an annotated copy of any figures of Davis with the alleged collapsible feature identified, in order to permit the applicant to understand the precise basis for the rejection.

(iv) In the Office Action of August 16, 2001, the Office Action appears to have taken the position that end compartment C in Davis is the second collapsible *insulated* container as recited in claim 1. The applicant respectfully submits that Davis neither discloses nor suggests that end compartment C is insulated.

(v) The Davis specification clearly contemplates and teaches a single insulated compartment, that is, main central compartment B. In particular, the specification of Davis provides that: “the central compartment B is a thermally insulated compartment with each and every side thereof and the top BT thereof being insulated in a conventional manner...” (column 3, lines 41 to 45). Davis does not describe, teach or otherwise suggest that either of end compartments A or C is an insulated compartment.

(vi) In fact, the description and the claims of Davis tend to suggest that end compartments A and C are not insulated compartments. In particular, Davis describes the different functions of the utility bag in the following passage at column 4, lines 9 to 17:

“As can be seen from the foregoing specification and drawings, the utility bag of the present invention serves may different functions such as carrying soft drinks in a central compartment B, game balls such as soccer balls and other athletic equipment or large items in extensible end compartment A, and relatively smaller and foldable items such as extra clothing, towels, etc. in the second end compartment C.”

It is apparent that Davis contemplates using central compartment B to carry soft drinks because it is a thermally insulated compartment. However, it is also apparent that uses for end compartments A and C do not rely on these compartments being insulated. On the contrary, it is respectfully submitted that use of end compartments A and C for “soccer balls and other athletic equipment” strongly suggest that these compartments are not insulated.

(vii) The claims of Davis tend to support the view that only central compartment B is insulated. More specifically, claim 7 of Davis, which depends from independent claim 1, includes the limitation that central compartment is thermally insulated. Moreover, independent claim 8 of Davis reads as follows:

“8. A sports utility bag comprising in combination:
a thermally insulated central section defining a food and beverage storage compartment comprising a top wall, bottom wall, parallel side walls and parallel end walls; first and second flexible end sections secured at the respective end walls of said central storage compartment such that said end walls of said storage compartment form respective common walls between said storage compartment and each of said first and second flexible end sections, each of said sections being further defined by a first end wall and one of said common end walls; said first flexible end section comprising a collapsible and *extensible first end storage compartment housing an extensible storage sleeve for sports paraphernalia*, said storage sleeve comprising said first end wall defining the outermost extremity of said extensible storage sleeve, said sleeve being extended from said common side wall defining the extent of said central storage compartment to said end wall of said sleeve; a fully peripheral slide fastener means for retaining said first extensible storage compartment in its collapsed state; and access means in said extensible storage sleeve providing for selective access to the interior of said extensible sleeve; said second flexible end section comprising a fixed dimension second end compartment including a slide fastener means for providing access to said second end compartment. [italics added for emphasis]

In claim 8, Davis recites that the thermally insulated central section defines a food and beverage compartment. Also recited, is the limitation that the extensible first end storage compartment houses an extensible sleeve for “sports paraphernalia”. Davis does not claim the insulated feature for any other compartment, and, as noted above, there would seem to be no reason to carry “sports paraphernalia” in an insulated compartment.

(viii) In light of the foregoing, the applicant submits that Davis does not disclose first and second collapsible *insulated* container portions as recited in applicant's claim 1 and respectfully requests under MPEP 707.07(f), that the Examiner identify, in the text of Davis, the insulated feature of either end compartments A and C; or (b) provide an annotated copy of any figures of Davis with the alleged insulated feature of end compartments A or C identified, in order to permit the applicant to understand the precise basis for the rejection.

(ix) It is further respectfully submitted that the specification of Davis neither describes nor teaches that the sidewall panels of end compartment C are insulated. In fact, the specification of Davis is silent as to the construction of the sidewall panels of end compartment C. The applicant has identified no reference in Davis to the sidewall panels of end compartment C which teaches or otherwise suggests that the sidewall panels are insulated. In addition, there is no inherent reason for positing that the sidewall panels of end compartment C are insulated. Accordingly, Davis cannot serve as an anticipatory reference as it does not teach each and every feature of claim 1.

Claims 19 – 23 and Davis

The applicant states the foregoing not only in respect of claim 1, but also in respect of claims 19 – 23 and 29 that depend from claim 1. Accordingly, the applicant respectfully submits that claims 19 to 23 and 29 are allowable over Davis.

Claim 28 and Davis

In the context of claim 28, the applicant repeats the foregoing arguments to the extent applicable. Davis neither teaches nor shows two *insulated* container portions. Davis neither teaches nor describes two *collapsible* container portions. These features are thus missing from the utility bag of Davis. Accordingly, Davis cannot anticipate claim 28, or any claim dependent therefrom.

Re: Creamer et al.

The Office Action has taken the position that Creamer et al. anticipates claim 1. As noted above in the context of Davis, to anticipate claim 1 the law requires that Creamer et al. have all of the features of the claim, in exactly the same situation and united in the same way to perform the same function.

In the second Office Action (made final) of August 16, 2000 in connection with the parent case, the Office Action has taken the position that the container of Creamer et al. is collapsible to the same degree as claimed. In the first Office Action of August 16, 2001 in the present continuation, the Office Action further stated that: "To the degree that Creamer et al. does not disclose the second insulated container portion 3 as being made from a rigid material, the second insulated container portion 3 is capable of being collapsed as claimed. Furthermore, the first insulated wall structure of the first collapsible insulated container portion 5 is found in the common wall segregating the container portions 3 and 5."

The applicant respectfully traverses the rejection of claim 1 on the basis that Creamer et al. does not teach, disclose, or otherwise suggest each and every feature of the claim. More specifically, the applicant respectfully submits that:

- (1) Creamer et al. does not teach the *insulated* feature of the first and second collapsible container portions recited in claim 1;
- (2) Creamer et al. does not teach the *insulated* feature of the sidewall panels of the first and second insulated wall structures as recited in claim 1; and
- (3) Creamer et al. does not teach the *collapsible* feature of the first and second insulated container portions recited in claim 1.

The applicant respectfully submits that any one of the foregoing differences is sufficient to overcome the rejection under 35 U.S.C. 102 according to *Dart Industries* and *Datascope, supra* and accordingly, respectfully requests that the rejection of claim 1 under 35 U.S.C. 102 on the basis of Creamer et al. be withdrawn.

The applicant comments as follows in regard to Creamer et al.:

- (i) In the Office Action of August 16, 2001, the Examiner appears to have taken the position that upper compartment 5 is the first collapsible *insulated* container portion recited in claim 1. The applicant respectfully submits that the specification of Creamer et al., does not support this.

In this regard, the abstract of Creamer et al. teaches that: “the backpack is comprised of two sections, one of which is a thermally insulated compartment for carrying articles that need to be kept cold or warm”.

In the preferred embodiment of Creamer et al., compartment 3 located within the lower end of the backpack is specifically identified as a thermally insulated compartment (see column 3, lines 9 to 11). The second compartment, upper compartment 5 is located above the thermally insulated compartment 3 and is described as being not insulated. This is clearly and explicitly stated in the summary of the invention of Creamer et al., at column 2, lines 2 to 4, which read as follows: “There is at least one other compartment which in the preferred embodiment is an upper compartment as well which is not insulated” [underline added for emphasis].

From the foregoing, it is clear that the upper compartment 5 cannot be the first collapsible *insulated* container portion of claim 1 as alleged in the Office Action.

(ii) Creamer et al. discloses a backpack having one insulated compartment 3 and one non-insulated upper compartment 5. The backpack of Creamer et al. does not have first and second *insulated* container portions as recited in claim 1. Accordingly, it is respectfully submitted that Creamer et al. does not teach all the features of claim 1 and cannot form the basis of anticipation rejection.

(iii) The specification of Creamer et al. neither describes nor teaches that the sidewall panels of end compartment C are insulated. In fact, the specification of Creamer et al. is silent as to the construction of the sidewall panels of end

compartment C. The applicant has identified no reference in Creamer et al. to support the contention that the sidewall panels of end compartment C are insulated. In addition, there is no inherent reason for positing that the sidewall panels of end compartment C are insulated. As Creamer et al. does not disclose all the features of claim 1, it cannot form the basis for an anticipation rejection.

(iv) In respect of the claimed *collapsible* feature of the first and second insulated container portions of claim 1, it is respectfully submitted that Creamer et al. does not disclose, teach or otherwise suggest that both thermally insulated compartment 3 and upper compartment 5 are collapsible. There is no mention in Creamer et al. that the insulated compartment 3 is collapsible. In this regard, Creamer et al. states: "When the backpack is not in use, it can be compactly folded up around the insulated and firmer lower section." (column 2, lines 41 to 43). This tends to suggest that the upper compartment 5 may be folded onto the lower, insulated compartment 3. However, the specification of Creamer et al. does not disclose that the insulated compartment 3 is itself collapsible. The applicant respectfully submits that the foregoing passage appears to suggest otherwise as the lower insulated compartment is the form of the "firmer lower section" about which the backpack may be folded. Thus, Creamer et al. cannot be an anticipatory reference.

(v) In the Office Action of August 16, 2001, the Office Action has taken the position that "...to the degree that Creamer et al. does not disclose the insulated compartment 3 as being made from a rigid material, the second insulated container portion 3 is capable of being collapsed as claimed". The applicant respectfully submits that the Creamer et al. provides no support for such an assertion.

Furthermore, the fact that Creamer et al. uses insulated compartment 3 as the form about which the rest of the backpack can be folded suggests otherwise.

(vi) Creamer et al. states: "The backpack utilizes a housing formed from a combination of semi-flexible, composite, insulated, and waterproof material, as the means to insulate the lower section. The composite material is located between layers of the semi-flexible material in an area surrounding the thermally insulated compartment." (column 2, lines 4 to 11). There is no mention in the specification that either of these materials are collapsible. Moreover, some composite materials are known to be rigid and thus non-collapsible. The term "semi-flexible" appears to suggest that the materials were not intended to be fully-flexible, as might be implied by an ability to collapse. Accordingly, while nothing in the reference points to collapsibility, by contrast, there are identifiable grounds upon which to infer that the composite material is not collapsible.

(vii) The Examiner has a positive duty to show that the claimed features are in the cited reference in order to substantiate a rejection under 35 U.S.C. 102. The applicant respectfully submits that Creamer et al. does not disclose the collapsible feature of the lower insulated compartment 3, and respectfully requests under MPEP 707.07(f), that the Examiner identify, in the text of Creamer et al., the collapsible feature of insulated compartment 3; or (b) provide an annotated copy of any figures of Creamer et al. with the alleged collapsible feature identified, in order to permit the applicant to understand the precise basis for the rejection.

Claims 19 to 21, 23 and 24 and Creamer et. al.

To the extent applicable, the applicant repeats the commentary made in the context of claim 1 with regard to Creamer et al. The applicant submits that claims 19 to 21, 23 and 24 are allowable over Creamer et al.

Claim 22 and Creamer et al.

To the extent applicable, the applicant repeats the commentary made in the context of claim 1 with regard to Creamer et al. In addition, the applicant respectfully submits that Creamer et al. does not show the feature of the closure member of the lid being a tracked closure member. In this regard, the specification of Creamer et al. provides that: "The access opening panels 16 and 22 are fastened in a closed position to the upper and lower compartment respectively using a fastening material like hook and loop 28. The velcro like material is covered over by flaps 32 and 34." (column 3, lines 42 to 46). Accordingly, it is respectfully submitted that claim 22 is not anticipated by Creamer et al. since this reference does not teach the tracked closure member recited in the claim.

Claim 25 and Creamer et al.

To the extent applicable, the applicant repeats the commentary made in the context of claim 1 with regard to Creamer et al. In addition, the applicant respectfully submits that Creamer et al. does not teach, disclose or otherwise suggest all the

features in claim 25. More specifically, the common wall in Creamer et al. is not fixed as recited in claim 25. In Creamer et al. the common wall is a dividing member or dividing means 21. It is described in the following terms in the specification: "The dividing member between the upper and lower compartments is comprised of a shelf which is pivotably supported on the housing and can be moved in an upright position when the upper and lower compartments are made into one single larger compartment." (column 2, lines 31-36). Creamer et al. specifically teaches that the dividing member is moveable. The applicant respectfully submits that claim 25 is presently allowable over Creamer et al.

Claim 28 and Creamer et al.

In the context of claim 28, to the extent applicable, the applicant repeats the commentary made in the context of claim 1 with regard to Creamer et al. The applicant submits that claim 28 is allowable over Creamer et al.

Re: Jacober

Claim 1 was rejected as anticipated by Jacober. As noted above in the context of Davis, to anticipate claim 1 the law requires that Jacober have all of the features of the claim, in exactly the same situation and united in the same way to perform the same function.

The applicant respectfully traverses the rejection of claim 1 on the basis that Jacober does not teach, disclose, or otherwise suggest each and every feature of the claim. More specifically, the applicant respectfully submits that:

- (1) Jacober does not teach or describe the *insulated* feature of the sidewall panels of the first and second insulated wall structures recited in claim 1; and
- (2) Jacober does not teach the *collapsible* feature of the first and second insulated container portions recited in claim 1.

The applicant respectfully submits that any one of the foregoing differences is sufficient to overcome the rejection under 35 U.S.C. 102 according to *Dart Industries* and *Datascope, supra* and accordingly, respectfully requests that the rejection of claim 1 under 35 U.S.C. 102 on the basis of Jacober be withdrawn.

The applicant respectfully submits the following in support of its stated position:

- (i) Jacober describes an injectable medication carrying case 20 that includes a top panel 22, a bottom panel 24 opposite the top panel, two opposing side panels 26 and 28, two opposing end panels 30 and 32, and a carrying handle 33 (column 3, lines 4-8). The carrying case 20 also has a thermally insulating divider panel 48 that partitions the case into two distinct compartments, (that is, a cool compartment 46 and a room temperature compartment 72). Cool compartment 46 is defined by the bounded volume of top panel 22 and divider panel 48, side panel 26 and side panel

28, and end panel 30 and end panel 32 (column 3, line 67 to column 4, line 6). The specification further provides that the room temperature compartment 72 is defined by the bounded volume of bottom panel 24 and divider panel 48, side panel 26 and side panel 28, and end panel 30 and end panel 32 (column 5, lines 18 to 24). The applicant submits that a person skilled in the art would not regard the room temperature compartment as having an insulated sidewall such as to make the second chamber an insulated chamber.

(ii) The specification of Jacober does not describe the construction of the sidewall panels of compartments 46 and 72. The applicant has found no reference in Jacober to support the contention that the sidewall panels of either cool compartment 46 or room temperature compartment 72 is insulated. Accordingly, the applicant respectfully submits that as Jacober does not disclose all the features of claim 1, it cannot form the basis for an anticipation rejection.

(iii) In respect of the claimed *collapsible* feature of the first and second insulated container portions of claim 1, it is respectfully submitted that Jacober does not disclose, teach or otherwise suggest that either cool compartment 46 or room temperature compartment 72 is collapsible. In particular, the applicant notes that there is nothing in the description of Jacober that points to either of the compartments 46 or 72 being collapsible. There is no mention in Jacober that either compartment 46 or 72 is collapsible. Moreover, there is no inherent reason for positing that either compartment 46 or 72 is collapsible. Thus, Jacober cannot be an anticipatory reference.

Claims 2, 23, 24, 28 and Jacober

To the extent applicable, the applicant repeats the commentary made in the context of claim 1 with regard to Jacob. The applicant submits that claims 2, 23 and 24 are allowable over Jacob.

Claim 28 and Jacober

To the extent applicable, the applicant repeats the arguments made above concerning Jacober. The applicant notes that there is no apparent suggestion in Jacober that either compartment is movable to a collapsed position, or that either compartment is securable in a collapsed position. The applicant submits that claim 28 is presently allowable over the art of record in the present case.

Claims 34 - 36 and Jacober

To the extent applicable, the applicant repeats the commentary made in the context of claim 1 with regard to Jacob. The applicant submits that for the reasons stated at length above, claim 34 to 36 are presently allowable over Jacob.

(c) **Arguments concerning rejections based on 35 U.S.C. 103 - Obviousness**

Claims 2, 4 and 34 -37

Claims 2, 4 and 34 to 37 were rejected as being unpatentable over Davis in view Lin. More specifically, the Office Action has taken the position that Davis discloses the claimed device, except for the first container portion B having a liner and that Lin discloses that it is known in the art to provide a liner in analogous insulated container portion. According to the Office Action, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the insulated container portion B of Davis with the liner of Lin, in order to prevent the insulated wall structure from being moistened by cold drinks or food.

The applicant respectfully traverses all of these rejections.

For the reasons discussed above, both Davis and Lin lack features of the independent claim 1 from which claims 2, 4 and 34 to 37 ultimately depend. Since the cited prior references do not show all the limitations of claim 1, a *prima facie* rejection on the basis of obviousness has not been established. Accordingly, the applicant respectfully requests the rejections based on obviousness be withdrawn and that claims 2, 4 and 34 to 37 be allowed.

(6) **Amendments to the Specification**

As noted above, the specification has been amended to reflect the fact that the subject application is a continuation of U.S. Patent Application Serial No. 09/323,202 filed June 1, 1999, now issued as U.S. Patent No. 6,243,677 which is itself a continuation-in-part of United States Patent Application Serial No. 09/199,287 filed November 25, 1998 and issued to United States Patent No. 6,238,091. The change is shown in the enclosed sheet entitled, **"MARKED-UP COPY OF THE ORIGINAL SPECIFICATION"**

(7) **Conclusion**

In view of the foregoing arguments and amendments the applicant submits that all of claims 1, 2, 4 and 19 to 44 are presently allowable over the art of record in the case. Therefore the applicant requests early and favourable disposition of this application.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to Counsel's Deposit Account No. 01-2300.

Respectfully submitted,



Rhonda L. Barton
Attorney for Applicant
Reg. No. 47,271

ARENT FOX KINTNER PLOTKIN & KAHN, PLLC
1050 Connecticut Avenue, N.W., Suite 400
Washington, D.C. 20036-5339
Tel: (202) 857-6000
Fax: (202) 638-4810

RLB: ict

Enclosures: Marked-Up Copy of Original Claims 1 and 28
Marked-Up Copy of Original Specification
Petition for Extension of Time (3 months)
Check No.334883

MARKED-UP COPY OF ORIGINAL CLAIMS 1 AND 28

1. (Twice Amended) A soft sided, collapsible, insulated container comprising:
a first collapsible insulated container portion defining a first insulated chamber
therewithin; [and]
a second collapsible insulated container portion defining a second insulated
chamber therewithin;
said first and second insulated container portions having respective first and
second insulated wall structures, said insulated wall structures
including respective insulated sidewall panels;
said insulated chambers being located side-by-side, and being segregated by
[, said first and second container portions having] a common wall;
[said first container portion having a first insulated wall structure defining a
first enclosed chamber therewithin;]
said first insulated wall structure having a first opening defined therein for
providing access to said first enclosed chamber, a portion of said first
insulated wall structure being moveable to close said first opening;
[said second container portion having a second insulated wall structure
defining a second enclosed chamber therewithin;
said common wall segregating said first and second enclosed chambers from
each— other;]
said first chamber being maintainable at a different environmental condition
from [the environmental condition of] said second chamber.

28. (Amended) [The soft sided, collapsible insulated container of claim 1 wherein] A
soft
sided, collapsible, insulated container comprising:
a first collapsible insulated container portion, a second collapsible insulated
container portion and a common wall shared between said first and
second container portions;
said first container portion having a first insulated wall structure defining a first
enclosed chamber therewithin;

said first insulated wall structure having a first opening defined therein for providing access to said first enclosed chamber, a portion of said first insulated wall structure being moveable to close said first opening;
said second container portion having a second insulated wall structure defining a second enclosed chamber therewithin;
said common wall segregating said first and second enclosed chambers from each other;
said first chamber being maintainable at a different environmental condition from the environmental condition of said second chamber; and
said first container portion [is] being moveable between an expanded position and a collapsed position relative to said common wall, said first container portion being securable in said collapsed position.

MARKED-UP COPY OF AMENDMENTS TO THE SPECIFICATION

The following paragraph has replaced the paragraph beginning at page 1, line 1:

--This application is a continuation of United States Patent Application Serial No. 09/323,202 filed on June 1, 1999 and issued to United States Patent No. 6,243,677 which is itself a continuation-in-part of United States Patent Application Serial No. 09/199,287 filed November 25, 1998 and issued to United States Patent No. 6,238,091.--